

## **REMARKS**

Claims 19-25 stand rejected under 35 U.S.C. §101.

Claims 1-25 stand rejected under 35 U.S.C. §102(b) as anticipated by US Patent No. 6,144,954 to Li, hereinafter, Li

Claims 1, 5-8, 11-13, 17-19, and 23-25 are currently amended; claims 2-4, 9, 10, 14-16, and 20-22 are canceled. No new matter has been added to currently amended claims 1, 5-8, 11-13, 17-19, and 23-25. Claims 1, 7, 13, 19, and 25 are independent.

Applicants respectfully traverse these rejections based on the following discussion.

### **I. The 35 U.S.C. §101 Rejection**

The Office Action rejects claims 19-15 under 35 U.S.C. §101 because the claim limitations are directed towards computer programs *per se*. The Office Action further asserts that computer programs constitute non-statutory subject matter under the statute.

Applicant respectfully submits that independent claims 19 and 25 have been currently amended to recite in relevant parts, "A computer system for instructing a that executes an optimizing computer program ..." and "A computer system of autonomically that executes an optimizing [[a]] computer program ...," respectively. Applicant further respectfully submits that these amendments fulfill the statutory requirements of 35 U.S.C. §101 because a computer system is hardware, i.e., a physical object.

In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 19-15 under 35 U.S.C. §101.

## II. The Prior Art Rejections

Claims 1-25 stand rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 6,144,954 to Li, hereinafter, Li. Applicants respectfully traverse these rejections based on the following discussion.

The Office Action asserts that the claim element of "inputting commands into said program" in independent claims 1, 13, and 19 is disclosed by Li in col. 10, lines 40-42, i.e., "... the initial knowledge set to be associated with the computer software."

Applicant respectfully replies that independent claims 1, 13, and 19 have been currently amended to include the feature of "inputting a selection command that selects one function from a list of pre-selected functions into said computer program" (Claims 1 and 13) and "inputs a selection command, said selection command selecting one function from a list of pre-selected functions into said computer program" (Claim 19). A function, as defined by the 4th edition of the Microsoft Computer Dictionary, and as known to one of ordinary skill in the art, may be considered as a subroutine that may return a value dependent on its inputs. A function, therefore, should not be considered as a datum or a specification.

As a convenience to the Examiner, Applicant respectfully points out that currently amended and independent claims 1, 13, and 19 have incorporated the feature of inputting a selected function from canceled (and formerly dependent) claims 4, 16, and 22, and have added the feature of inputting a selected function to currently amended and independent claims 7 and 25. Therefore, all of the independent claims of the pending application incorporate the feature of inputting a selected function.

Applicant respectfully submits that the initial knowledge set 78 of Li, however, constitutes a data set or a set of specifications, again, data. Li discloses "... the disclosed self-optimizing method and machine (SOM) operate according to the steps of obtaining data and specifications associated with procedures in steps 40, equipment in step 42, materials in step 44, parts in step 46, personnel in step 48, environment in step 50, rules and regulations in step 52, and preliminary designs in step 54. ... In particular, the preliminary design may be obtained in step 54 by receiving in step 56 data and specifications from a human operator, another SOM, a pre-specified average design, and/or a randomly generated preliminary design." (col. 9, lines 52-65).

Li further discloses that "[t]he data and specifications from steps 40-54 are process by a computer aided (or automated) planning (CAP) procedure in step 59 to generate a plan. The plan is then implemented in step 60 by a computer aided (or automated) engineering (CAE) procedure to generated [sic] an engineered result, which is then tested in step 62 by a computer aided (or automated) testing (CAT) procedure. The test results from step 62 are then processed in step 64 by a computer aided (or automated) optimization (CAO) procedure, to generate an optimization of the received data in step 40-54 to form an optimal knowledge base." (col. 9, line 66 to col. 10, line 9).

Applicant respectfully submits that "the initial knowledge set (or knowledge base) to be associated with the computer software" disclosed by Li in col. 10, lines 40-42 and cited by the Office Action is a data set and does not constitute "one function from a list of pre-selected functions," as recited in currently amended and independent claims 1, 7, 13, 19, and 25, because a datum does not constitute a function.

For at least the reasons outlined above, Applicant respectfully submits that Li does not disclose all the features of currently amended independent claims 1, 7, 13, 19, and 25 under 35 U.S.C. §102(b). Therefore, Li does not anticipate the claimed invention. Withdrawal of the rejection of independent claims 1, 7, 13, 19, and 25 and dependent claims 5, 6, 8, 11, 12, 17, 18, 23, and 24, that is, all the pending claims, is respectfully solicited.

### **III. Formal Matters and Conclusion**

With respect to the rejections to the claims, the claims have been amended, above, to overcome these rejections. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the rejections to the claims.

In view of the foregoing, Applicants submit that claims 1, 5-8, 11-13, 17-19, and 23-25, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary. Please charge any deficiencies and credit any overpayments to Attorney's Deposit Account Number 09-0441.

Respectfully submitted,

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